

REMARKS

Claims 1, 4-6, 8, 10, 15, 19, 22, and 24-31 have been amended. Claims 3, 12-14, and 16-18 have been cancelled. No new matter is added as a result of the above amendments. Reconsideration of pending claims 1, 2, 4-11, 15, and 19-31 is respectfully requested in light of the above amendments and the following remarks.

Claim Objections

The Applicants kindly thank the Examiner for renumbering the claims. Claims are now listed as 1-31. Appropriate amendments to claims 24-31 have been made to provide an appropriate chain of dependency.

Double Patenting

Claims 1-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of the co-pending Application No. 10/712880 (“’880 application”). The grounds of this rejection are respectfully traversed, because it has several fundamental defects that are discussed separately below.

A first defect is that the double-patenting rejection based on the ’880 application makes a relatively vague assertion that a group of claims in the present application recite effectively the same invention as a group of claims in the ’880 application. But in order to be proper, the double patenting rejection must set forth a one-to-one correspondence between each pending claim of the present application and a respective one of the claims of the co-pending application. For example, the rejection would need to specify that Claim A of the present application is obvious from Claim X of the co-pending application, Claim B of the application is obvious from Claim Y of the co-pending application, Claim C of the application is obvious from Claim Z, and so forth. The Office Action fails to do this.

A second defect relates to the fact that, as to each of the double patenting rejections, the present Office Action admits that Applicants' claims are not identical to the claims in the co-pending application, and then essentially makes a statement because they would yield the “same

result of determining a price based on the quote amount associated with the product and the desired quantity of the product.” However, in any obviousness analysis, the Examiner is required to specifically identify for each rejected claim: (A) the differences between the rejected claim and the corresponding claim of the co-pending application, (B) the modification needed in the subject matter of the claim from the co-pending application in order to arrive at the subject matter of the rejected claim, and (C) a statement of a reason why a person of ordinary skill in the art would have been motivated to make the proposed modification. MPEP §706.02(j). The present Office Action fails to do any of this, and therefore fails to properly set forth a prima facie case of obviousness-type double patenting.

A third problem with the double patenting rejection is that the claims of the present application include limitations that differ from the current claims in the copending application. The claims of the ‘880 application have been amended and it is unclear which versions the Examiner is referencing. As an example however, claim 1 of the ‘880 application currently provides:

A computer-implemented method for linking a semiconductor product manufacturing facility order with a quotation, the method comprising: receiving the quotation including at least a first product and its quote amount; storing the quote amount associated with the first product in a quotation database; storing predetermined information associated with the first product in a product database; updating a mapping database record associated with the first product with the predetermined information from the quotation database and the product database associated with the first product, wherein the mapping database associates information of the quotation from the quotation database with information of the first product from the product database; receiving the product manufacturing facility order that identifies at least the first product and desired quantity; retrieving a mapping database record associated with the first product from the mapping database; and calculating an order price based on the mapping database record comprising the quote amount associated with the first product, and the desired quantity identified in the product manufacturing facility order.

Applicants' current Claim 1 provides for several limitations not found in Claim 1 of the '880. For example, Applicants' Claim 1 provides for a method to link a demand planning system and a quotation as opposed to linking an order with a quotation which is the subject of Claim 1 of the '880. Furthermore, Applicants' Claim 1 includes limitations associated with a raw material product and a finished product not found in the claims of '880. Yet still, Claim 1 of the '880 application provides for calculating an order price while Applicants' Claim 1 provides for calculating a demand planning system price associated with a desired finished product. Numerous other distinctions exist.

Still another consideration is that each of the double-patenting rejections is indicated to be a provisional double-patenting rejection, due to the fact that neither of the co-pending applications has actually issued as a patent. On the one hand, it is permissible for the Examiner to identify a rejection as "provisional" where the rejection is based on another application. On the other hand, it is also important to understand that, unless and until the other application issues as a patent, there is no actual risk of a double-patenting situation, and thus no reason for Applicants to take any corrective action here, such as submitting a terminal disclaimer. Moreover, for reasons discussed in other portions of these remarks, it is believed that all other grounds of rejection in the present Office Action are without merit, such that the provisional double patenting rejections are the only remaining rejections in this application. MPEP §804(I)(B) specifies that, where a provisional double patenting rejection is the only remaining rejection in an application, the Examiner should withdraw the provisional rejection, permit a patent to issue from that application, and then apply a double patenting rejection in the other pending application. Accordingly, Applicants believe that, pursuant to MPEP §804(I)(B), the Examiner should withdraw the double-patenting rejection in this application, and issue a notice of allowance.

In view of the various different reasons discussed above, it is respectfully submitted that the double patenting rejections each have defects. It is therefore respectfully submitted that the double patenting rejections should be withdrawn.

Rejections under 35 U.S.C. §103(a)

Claims 1-2, 4-12, 14-20, and 22-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shavit (US Patent No. 4,799,156 hereinafter referred to as "Shavit").

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

CLAIM 1

THE PRIOR ART DOESN'T TEACH ALL CLAIM LIMITATIONS

The provisions of MPEP §2142 specify with respect to §103 that:

To establish a *prima facie* case of obviousness...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. (Emphasis added).

The PTO considers this requirement to be important, as evidenced by the fact that this exact language appears not only in MPEP §2142, but also in other sections of the MPEP, including MPEP §706.02(j) and MPEP §2143. Shavit does not provide all limitations of Claim 1.

Claim 1 requires:

A computer-implemented method for linking a semiconductor product manufacturing facility demand planning system with a quotation system, the method comprising:
updating the quotation system including a first raw material product and its quote amount;
storing the quote amount associated with the first raw material product in a quotation system database;

determining that the first raw material product is associated with a desired finished product and a quantity of the first raw material product associated with the desired finished product; and calculating a demand planning system price associated with the desired finished product based on the quote amount associated with the first raw material product and the quantity of the first raw material product associated with the desired finished product.
(Emphasis added.)

The Examiner asserts that Shavit provides the limitations of Claim 1 by citing an *extensive* number of lines of the Shavit specification. Contrary to the Examiner's assertions as the Applicants understand them to be however, Shavit does not disclose identifying a desired finished product and determining that the first raw material product is associated with the desired finished product and a quantity of the first raw material product associated with the desired finished product as required by Claim 1. Applicants find no mention in the referenced portions of Shavit to a raw material product associated with a finished product. As such, the referenced portions of Shavit also do not provide for calculating a demand planning system price associated with the desired finished product based on the quote amount associated with the first raw material product and the quantity of the first raw material product associated with the desired finished product, as also required by claim 1.

The Examiner asserts that Shavit teaches at Col. 13 line 51 – Col. 14 line 9 providing a system that identifies a first raw material product and desired quantity to produce a finished product. However, this portion of Shavit provides only for entry of a purchase order by a buyer. The system “helping to identify the required items (from the entry), proposing substitutes and complementary items, validating various data items and computer such values as weight and volume of the ordered items” and the section continues to disclose order confirmation procedures. Col. 13 line 51 – Col. 14 line 9.

The Examiner asserts Shavit teaches at Col. 13 line 10 – Col. 14 line 9, Col. 25 lines 28 – 50 determining a demand planning system price. However, at Col. 13 line 10 – Col. 14 line 9, Shavit discloses only permitting a buyer to enter and submit a request for quotation (RFQ),

calculating such values as weights, volume, etc., recalculating the prices and terms of a previously reviewed bid, and ordering against a master purchasing agreement providing for a fixed price as well as the submission of purchase orders described above. Shavit fails to disclose calculating a demand planning system price associated with the desired finished product based on the quote amount associated with the first raw material product and the quantity of the first raw material product associated with the desired finished product as required by Claim 1. Shavit at Col. 25 lines 28 – 50 discloses a system that “attempts to prepare a bid based on database information” in response to an input RFQ, further allowing the bid to be stored for later reference. Column 25, lines 37-39. In the Abstract, Shavit discloses that “[t]he system includes a data base which contains user information.” At column 7, lines 23-26, Shavit discloses “a local data base which may include a complete data base for individual subscribers as well as a partial data base of a subscriber.” As such, again Shavit fails to disclose calculating a demand planning system price associated with a finished product based on a quote for a raw material product as required by Claim 1.

Therefore, contrary to the Examiner’s allegations, Shavit fails to disclose the features of claim 1 in the above sections or the other sections of the reference cited by the Examiner. Thus, the rejection of claim 1 under 35 U.S.C. §103 is not supported by the reference and should be withdrawn.

CLAIMS 19 and 23 - §103

Claim 19 requires in part:

... determining a quantity of the first raw material product associated with manufacturing the finished product;
calculating a demand planning system price associated with the first raw material product by accessing the quote amount associated with the first raw material product, and
determining the demand planning system price based on the quote amount associated with the first raw material product and the quantity of the first raw material product associated with manufacturing the finished product.

The Examiner provides citations similar to those discussed above in reference to Claim 1. For reasons substantially similar to those discussed above with reference to Claim 1, the portions of Shavit cited by the Examiner do not provide disclosure all the limitations of Claim 19. For example Shavit does not disclose identifying a finished product and determining a quantity of raw material associated with manufacturing the finished product, nor does it disclose determining a demand planning system as required by Claim 1.

Claim 23 requires in part:

...a demand planning system entry device for entering a finished product and required raw material products and desired quantities; and a price calculator configured to receive the desired quantities of raw materials from the demand planning system entry device, to access the memory to identify the quote amounts associated with the raw materials, and to calculate a price for the finished product based on the desired quantities and quote amounts of raw materials.

The Examiner asserts claim 23 is disclosed by Shavit at Col. 11 line 52- Col. 12 line 18, Col. 16 line 50 – Col. 17 line 2, Col. 33 line 28 – Col. 34 line 2, and Col. 40 lines 27-35. However, for reasons substantially similar to those discussed above with reference to Claim 1, the portions of Shavit cited by the Examiner do not provide disclosure for the limitations of Claim 23.

As to the Examiners additional cited portions of Shavit, these too do not disclose all the limitations of Claim 23. Shavit in Col. 11 line 52- Col. 12 line 18 discloses a “buyer is advised about any outstanding incoming mail (e.g., incoming bids...)” continuing to describe categorization of the mail and the ability of the user to prepare documents and distribute them. Shavit in Col. 16 line 50 – Col. 17 line 2 discloses use of a system by a freight department of a shipper to communicate with carriers allowing a shipper to enter freight RFQ information and received bids based on the RFQ. Shavit in Col. 33 line 28 – Col. 34 line 2 discloses the customer service function which when selected and security validation completed, functional blocks may

be selected to provide a service. The blocks include providing pricing of RFQs, sales order entry by an agent, confirming orders, billing and shipping functions, financial reports and management reports generated, and price and catalog maintenance. In Col. 40 lines 27-35 Shavit claim language discloses transaction means including requesting and receiving price quotations, mortgaging inventory, placing and amending orders, direct shipment instructions and so forth. Thus, it is clearly apparent that none of the cited portions provide any disclosure of a finished product and a required raw product as described in Claim 1. Nor do the portions of Shavit provide for calculation of a price for the finished product based on the desired quantities and quote amounts of raw materials, also as required in Claim 1.

Claims 19 and 23 are therefore believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2, 4-11, and 15, Claims 20-22, and Claims 24-31 respectively depend from Claim 1, Claim 19, and Claim 23, and are also believed to be allowable over the art of record, for example, for the same reasons as Claims 1, 19, and 23, respectively.

Furthermore, Claim 4 requires wherein the determining that the first raw material product is associated with the desired finished product and the determining the quantity of the first raw material product associated with the desired finished product includes accessing a product database, and wherein the product database includes a listing of a plurality of raw material products associated with the finished product. The Examiner cites numerous sections of Shavit as providing a database however, the Applicants find no mention of a product database including a plurality of raw materials associated with a finished product. For similar reasons, Claims 15 and 22 are also believed to be allowable for at least this independent reason.

Claim 5 requires providing a mapping system and updating a mapping database with information from the quotation system database and the product database associated with the first

raw material product using the mapping system. The Examiner cites Col. 24 line 53 – Col. 25 line 9, Col. 31 line 32 – Col. 32 line 9, Col. 36 lines 22-53, Col. 40 lines 28-35 as providing a mapping system. However, none of the cited portions of Shavit disclose a mapping system, much less a mapping database.

At column 24, line 53 – column 25, line 9, Shavit merely discloses determining the type of service for billing (database service or computing service) and linking the user to the selected programs. However, there is no disclosure of a mapping system or mapping database as required by Claim 1. At column 31, line 32 – column 32, line 9, Shavit discloses information on an automatic information service that “provides application programs for accessing the distributor data base and provides data processing functions on behalf of the distributor when dealing with other parties.” (column 31, lines 2-5). The functions that the service of Shavit performs include maintaining a promotional interactive session, answering customer inquiries and generating online reports, automatic order amendments, automatic sales order entry, and automatic bidding (Fig. 21). However, there is no disclosure of a mapping system or mapping database as required by Claim 1.

At column 36, lines 22-53, Shavit discloses freight carrier operations that comprise preparation and review of manually and automatically generated bids; entry, amendment, and review of reservation records; entry, retrieval, and review of documentation; entry and review of scheduling and status information; management of bulletin board offerings, and operation of submission of invoices and statements through the system. However, there is no disclosure of a mapping system or mapping database as required by Claim 1.

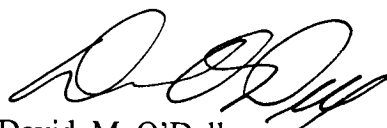
At column 40, lines 28-35, Shavit discloses transaction means including requesting and receiving price quotations, mortgaging inventory, placing and amending orders, direct shipment instructions and so forth. However, there is again no disclosure of a mapping system or mapping database as required by Claim 1.

For substantially similar reasons as discussed above, the mapping systems of claims 6-9 and 28-30 are also not provided by Shavit including in the additional portions of Shavit cited by the Examiner.

Conclusion

It is clear from all of the foregoing that all pending claims are in allowable form. An early formal notice of allowance of claims 1, 2, 4-11, 15, and 19-31 is requested.

Respectfully submitted,



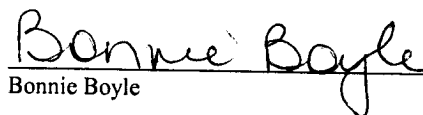
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